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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,216	12/22/1999	DALE F. MCINTYRE	80121F-P	5901

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PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

(585)  
✓ Rubric (585) 588-2768  
Pat West 585-588-4525  
Paula

**Office Action Summary**

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant filed a Request for Continued Examination, amended the specification, and amended Claims 1, 10, 17, 20, 62, and 71. All pending claims, 1-76 were examined in this non-final office action.

### ***Response to Arguments***

The Applicant's arguments focus on providing a particular product or service to the customer based on achieving pre-determined criteria. Specifically, the product contains digital images associated with the customer aggregated over time or after reaching a specified number of images. This is consistent with discussions held with the Applicant's legal representative, Mr. Frank Pincelli, in a telephonic interview following the Final Office action.

The Applicant's arguments are moot based on new grounds of rejection. It is this examiner's contention that the claimed invention is an archival service. This examiner recognizes the potential benefits to the assignee (e.g. providing a product to the customer after a certain amount of business has been achieved, creating customer loyalty due to ease of use of product, promoting sales, improving competitive position by reducing cost of removable storage); however, the cited prior art is capable of performing the intended use, and in doing so, provides a product to customer on compact disk after achieving pre-determined

Art Unit: 3625

criteria. New art is cited in this non-final rejection that introduces a) archival services for hire, b) archival services for hire specific to compact disk as archival media, c) distribution of archived information directly to customers on compact disk as a photo album, and d) archiving techniques implementing time-based and space management threshold criteria. Key aspects of each new art is cited below for the Applicant's convenience:

1. (PTO-892 Item: U): Kodak's Photonet online service purging a customer's photos after 30 days unless a charge for storage is paid; establishes Kodak's use of time-based criteria as a means for managing online storage and charging for storage beyond the pre-determined criteria; establishes Fuji Photo's Fujifilm.net as a competing online photographic service,
2. (PTO-892 Item: U): Photofinishers charging customers for storing their digitalized photos on a CD-ROM product,
3. (PTO-892 Item: V): Using Kodak's Flashpix to aggregate and archive up to 100 digitized photo images onto a Flashpix CD-ROM, and thereby eliminating the restriction of one roll of exposed images per CD-ROM; establishes basis for aggregating more than one roll of images onto a single CD-ROM,
4. (PTO-892 Item: W): Kodak's competitor Fujifilm providing a photographic album service that enables customers to drop off their Fujifilm at Fujifilm retail shop, and receive a Flashpix CD of their photos along with software

that helps them visually organize all graphic, audio, video, and slide show files,

5. (PTO-892 Item: X): Kodak's Michael Tenalio seeing explosive growth in the adoption of CD-based systems for archival storage and distribution to different locations; Interlogic finding about 40 largest clients wanting copies of their records delivered on CD, and
6. (Crouse et al., US 5,764,972): Establishing automatic archiving of information onto secondary storage in distributed computing environments (e.g. removable optical media) and using pre-determined time-based or space management threshold criteria.

### ***Drawings***

1. New corrected drawings are required in this application because at least Figures 1-2, 4-5, 7-8, and 10 do not meet margin requirements as required in 37 CFR 1.84. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 1-4 and 8-9 are rejected under 35 USC 103(a) as being unpatentable over Florida Times Union (PTO-892, page 1, Item: U), in view Archiving (a collection of articles cited in PTO-892, page 1, Items: V-X, and PTO-892, page 2, Items: U-V), further in view of Crouse, patent number 5,764,972.**

Florida Times Union teaches Kodak's web-based online photo service, Photonet ([www.kodak.photonet.com](http://www.kodak.photonet.com)), competing against archrival Fuji Photo Film's Fujifilm.net ([www.fujifilm.net](http://www.fujifilm.net)). Florida Times Union teaches both online services storing a consumer's photos on the web for 30 days and charging extra to keep them online longer, customers receiving secret access codes when they pick up their prints and using the access codes to view the digital images online, downloading photos to their hard drives, sending photos via email, and ordering reprints or personalized products. Florida Times Union further teaches a) consumers being charged by either service to scan rolls of film resulting in the digital image being placed online for future access or placed onto a CD-ROM, b) Fujifilm album software being used to organize picture and posting albums on the

Art Unit: 3625

web, and c) Photonet's online photo album providing image addition, deletion, and caption writing (please see PTO-892, page 1, Item: U, pages 1-2).

Florida Times Union teaches all the above as noted under the 103(a) rejection and further teaches services providing the option to have pictures scanned and transferred to a floppy disk or CD-ROM, but do not specifically disclose using the CD-ROM to store more than one roll of film. Archiving teaches Kodak's Photonet service notifying customers when online images can be downloaded for touchup, and customers uploading edited images to Photonet for printing or for digitally saving a roll on a CD-ROM in a special format developed by Kodak called FlashPix. Archiving teaches a consumer being able to store more than 100 digital exposures on a single CD-ROM without having to buy a new CD-ROM for every roll of film (see PTO-892, page 1, Item: V, page 3). Archiving teaches Fujifilm.net and Fujifilm/LivePix Album service that provides customers with their photos on Flashpix-CD, along with easy-to-use software that organizes, manages, and publishes images online via Fujifilm.net (see PTO-892, page 1, Item: W, pages 1-3). Archiving teaches Kodak's Michael Tenalio seeing explosive growth in the adoption of CD-based systems for archival storage and distribution to different locations, and further teaches Interlogic finding its 40 largest clients wanting copies of their records delivered on CD (see PTO-892, page 1, Item: X, pages 1-2). Archiving teaches archiving documents, photos, and records onto compact disks, and teaches Kodak and other companies providing CD drives being compatible with the archiving software (see PTO-892, page 2,

Item: U, page 1). Archiving teaches Kodak launching Photonet and paying for 30 days of archiving services, and further teaches Kodak drug chain retailers providing the online service to customers (see PTO-892, page 2, Item: V, page 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to provide Photonet or Fujifilm.net customers with archival services capable of aggregating digital images onto a CD-ROM as taught by Archiving, in order to provide customers with photo image-based products delivered on CD-ROM, and thereby increase service sales revenue.

Florida Times Union and Archiving teach all the above as noted under the 103(a) rejection and further teach a) the use of CD-ROMs for archiving photos featuring a range of archived images not limited to a single roll of film but limited only by the maximum capacity of the CD-ROM (e.g. up to 100 stored images), b) service providers charging consumer for storing photos on CD-ROMs as a product and sending to the customer, and c) establishing time as a pre-determined criteria affecting storage and cost of storage for digitized photos (e.g. 30 days), but do not specifically disclose a service provider sending the customer a CD-ROM once pre-determined criteria of time or number or images are reached. Crouse et al. teach an archiving file system to support the demands of distributed network environments. Crouse et al. teach the a system and method of archiving information to secondary storage devices (e.g. removable optical disks) using time-based or space management threshold criteria to automatically determine when archiving occurs onto removable optical media (see at least



Art Unit: 3625

abstract; col. 1, line 30 through col. 6, line 51; col. 15, lines 57-59; col. 16, lines 7-12; col. 21, lines 17-33, 50-67; col. 22, lines 8- ). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Florida Times Union and Archiving by incorporating automatic archiving onto CD or other secondary storage devices determined by reaching time-based or space management threshold criteria as taught by Crouse et al., in order to automatically provide a product to a customer.

- 3. Claims 5-7, 10-60, and 62-76 are rejected under 35 USC 103(a) as being unpatentable over Florida Times Union (PTO-892, page 1, Item: U), Archiving (a collection of articles cited in PTO-892, page 1, Items: V-X, and PTO-892, page 2, Items: U-V), and Crouse, patent number 5,764,972., as applied to Claim 1, in further view of Shiota et al., Paper #6 patent number 6,324,521, in further view of London Drug (a collection of articles cited in Paper # 6, PTO-892 Items: U and V), in further view of Komiya et al, Paper #6 patent number 6,155,025, and Official Notice.**

Florida Times Union, Archiving, and Crouse et al. teach all the above as noted under the 103(a) rejection and teach Fujifilm.net competing against Kodak's Photonet, but do not disclose details about Fuji Photo's online photographic service. Shiota et al. disclose a system and method of Fuji Photo Film Company of providing customers with a photographic service via a computer network. Shiota et al. teach a fulfillment center managing one or more

orders, routing photo processing jobs to minilabs and special laboratories, processing and delivering automatically to the customer a first set of prints, and customers connecting remotely to the service via the Internet for viewing, ordering extra prints or other products and services, and sharing with friends (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); Fig. 7 (6); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al. teach image retaining devices comprising one or more rolls of photographic film, creating a first set of prints and then electronically scanning and converting into digital images for online viewing (see at least Fig. 1 (7); col. 2, lines 33-41), storing digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and automatically providing a product (col. 9, lines 40-52, col. 10, lines 4-29). Registration information for an order comprises a reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al. teach the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service. Shiota et al. teach services and goods such as outputting prints, extra prints, picture postcard, and compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), generating pass codes for online access, and arrangements or images in an album (see at least col. 4, lines 28-42). Shiota et al. further teach ordering

information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a unique reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al. further disclose an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) whereby in Fig. 3 Order Information 1 represents ordering information for the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose full details of a competing service as taught by Shiota et al., in order to fully describe an online photographic service that competes against other online photographic service providers.

Florida Times Union, Archiving, Crouse et al. and Shiota et al. teach all the above as noted under the 103(a) rejection and teach an online photographic film service, use of photographic film, photographic film having an image ID number for each image on the film roll, a processing number that pertains to the type of service or services to be performed, a unique reception number to track the order, and an access code for Internet access, but do not specifically disclose how the reception number is generated or its association with a roll of film. London Drug teaches an online photographic service competing against Kodak and Fuji, and providing digital photo finishing by loading customer photos to the

Art Unit: 3625

Internet. At London Drug, a customer's roll of film is processed into prints, each individually checked for quality, securely loaded to the Internet web site, and optionally loaded into a private album. London Drug emails a personal roll ID code to the customer that creates a hot link directly connecting the customers' e-mail to the London Drug web site. Using the personal roll ID code assigned to each roll of film, a customer and their family or friends can retrieve the photographs from anywhere in the world over the Internet (see Paper #6, Item: U, page 1). London Drugs further teaches London Drug's Photo Station, Fuji's Picture Plus, and Kodak's Picture Maker having similar services, and specifically discloses the use of the roll ID to access images over the London Drug web site (see Paper #6, Item: V, page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Florida Times Union, Archiving, Crouse et al., and Shiota et al. to assign unique ID numbers to each roll of film as taught by London Drug, in order to associate one or more roll ID numbers with an Internet posting service or optional album posting, and thereby provide better image management and convenience for customers.

Florida Times Union, Archiving, Crouse et al., Shiota et al., and London Drug teach all the above as noted under the 103(a) rejection and further teach customer ordering convenience, issuing unique roll IDs to customers to facilitate convenience, and checking for quality during print processing, but do not disclose a) providing roll IDs based on the roll ID supplied with the roll of film, b)

Art Unit: 3625

associating multiple rolls of film with the package ID during registration, and c) photographic service receiving roll IDs into a database. Komiya et al. teach a system and method of Fuji Photo Film Company packaging photographic film comprising individually packaged roll of film and multiple rolls of film packaged in a single package. Komiya et al. teach each packaged roll of film having a unique ID number printed on the film, the cartridge, and the package. Komiya et al. further teach packaging containing multiple rolls as having a package ID that relates to each roll ID in the package, a central production information management system that retains ID information for quality and historical tracking purposes, detecting quality failures after film product is sold, and using ID information to effect recalls (see at least abstract; Fig. 2 (10, 14b, 32, 26, 40a, 40b); Fig. 21 (306b, 310b); col. 9, line 66 through col. 10, line 27; col. 11, lines 18-25; col. 16, lines 48-64; col. 20, lines 36-47; col. 22, lines 22-64). This examiner takes the position that since system and methods of Fuji Photo (Komiya et al.) seek to achieve improvements in product quality and teach product recall tracking, sharing the ID information with the Fuji Photo Film networked photographic service would provide additional quality data tracking typically sought by a manufacturing organization. Any problems with film quality detected at the print-processing end would automatically be correlated with the roll ID information already stored and being tracked. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Florida Times Union, Archiving, Crouse et al., Shiota

Art Unit: 3625

et al., and London Drug to use package roll IDs for quality assurance as taught by Komiya et al. and Official Notice, in order to link film roll product IDs with online processed customer images, and thereby close the loop between outgoing manufactured product and the photographic service.

- 4. Claim 61 is rejected under 35 USC 103(a) as being unpatentable over Florida Times Union (PTO-892, page 1, Item: U), Archiving (a collection of articles cited in PTO-892, page 1, Items: V-X, and PTO-892, page 2, Items: U-V), Crouse et al., patent number 5,764,972., Shiota et al., Paper #6 patent number 6,324,521, London Drug (a collection of articles cited in Paper # 6, PTO-892 Items: U-V), and Komiya et al, Paper #6 patent number 6,155,025, and Official Notice, as applied to Claim 59, further in view of Egan, patent number 6,273,986.**

Florida Times Union, Archiving, Crouse et al., Shiota et al., London Drug, and Komiya et al. and Official Notice teach all the above as noted under the 103(a) rejection and further teach printing unique film roll IDs on packages, but do not disclose a removable label that hides the ID. Egan teaches composite labels, package labeling systems and methods where the composite label serves as a combination of shipping label and packing list label with the shipping bar code indicia or other suitable indicia used for tracking purposes and identifying the contents of the package noted on the packing list (see at least abstract; col. 2, lines 32-36; col. 4, lines 18-22). The user removes the shipping label to reveal

Art Unit: 3625

the packing list that identifies package contents (see at least col. 3, lines 22-51).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Florida Times Union, Archiving, Crouse et al., Shiota et al., London Drug, and Komiya et al. and Official Notice to incorporate a removable label with hidden indicia as taught by Egan, in order to hide the unique roll ID from everyone other than the customer who purchased the film product.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

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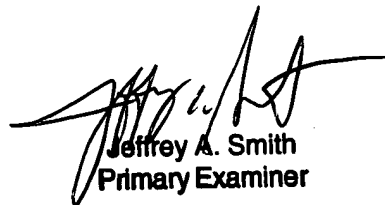
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or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
May 13, 2003

  
**Jeffrey A. Smith**  
**Primary Examiner**